

Appl. No. 09/995,931

AMENDMENT TO THE DRAWING FIGURES

Please add NEW Figures 3 and 4 as submitted herewith.

Appl. No. 09/995,931

REMARKS

[01] Applicant thanks the Examiner for the suggestion communicated by telephone on Dec. 14, 2005.

[02] In submitting this reply with RCE filing, Applicant has amended the claims and specification, as well as added new drawing figures, to further clarify the description and drawings.

[03] **Amendment to the Specification and Drawing Figures**

[04] New paragraph [0058.1] and Figure 3 are added to illustrate a simplified diagram of a second exemplary embodiment in accordance with the invention. Each element and block added can find support in the original description as listed below:

[05]

Block in new para. [0058.1] and new Figure 3	Described in original Specification paragraphs [...]
Block 301 – Preparing at least one article that is to be published in printed paper form for circulation by the publisher;	[026] lines 2-3, "...printed article that is to be published in print."
Block 302 – Assigning, by the publisher, the article with one unique tag prior to printing the article in printed paper form for circulation by the publisher;	[037] lines 2-4.
Block 303 – Publishing in circulation, by the publisher, both of the one article and its corresponding unique tag in printed paper form with its corresponding tag being printed in physical proximity to the article, the publisher also providing information indicative of a web site, an e-mail address and a telephone number for retrieval;	[037] lines 7-10; [038] lines 5-6, and [039] lines 6-7, "...the web site..."; [051] lines 1-2, "...send an email..."; [053] lines 1-3, "...dial to a publisher's number or an aggregator's number..."
Block 304 – Storing, by the publisher, the article in an electronic database, the article being uniquely retrievable based on the corresponding unique tag;	[037] lines 6-7.
Block 305 – Connecting, by the publisher, the database to the Internet, where the database is a telecommunication	[039] lines 6-8; [045] lines 7-12, 1-3;

Appl. No. 09/995,931

gateway adapted to transmit the request through wireless and landline telephone network;	[046] lines 1-5; [053] lines 2-3; [055] lines 1-2.
Block 306 – Receiving, by the publisher, a request from an Internet client through one of the web site, the e-mail address and the telephone number, the request including the at least one tag and information indicative of at least one of the client's telephone number and e-mail address, the tag having been previously observed by the client from the printed paper form in circulation, the client having previously registered at least one of the client's telephone number and the client's e-mail address with the publisher;	[038] lines 5-6; [039] lines 1-2, 6-10; [045] lines 7-10; [047] lines 1-12; [051] lines 1-3; [053] lines 1-3.
Block 307 – The publisher authenticating the client based on at least one of the client's telephone number and the client's e-mail address indicated by the request;	[039] lines 2-5; [053] lines 3-8.
Block 308 – Retrieving by the publisher from the database to locate the article in electronic form matching the tag, upon authenticating the client's request;	[038] lines 7-8; [043] lines 1-5; [047] lines 7-9; [051] lines 4-5.
Block 309 – Upon locating the article in electronic form from the database, the publisher electronically transmitting the article in electronic form to the client's email address, and	[038] lines 8-10; [047] lines 11-12; [051] lines 5-7.

[06] New paragraph [0058.2] and Figure 4 are added to illustrate a simplified diagram of a second exemplary embodiment in accordance with the invention. Each element and block added can find support in the original description as listed below:

[07]

Block in new para. [0058.2] and new Figure 4	Described in original Specification paragraphs [...]
Block 401 – Preparing a plurality of articles to be published in printed paper form for circulation by a publisher;	[026] lines 2-3, "...printed article that is to be published in print."
Block 402 – Assigning, by the publisher, each of the articles to at least one unique tag prior to printing in	[037] lines 2-4.

Appl. No. 09/995,931

printed paper form for circulation;	
Block 403 – Publishing in circulation, by the publisher, each of the articles in printed paper form with its corresponding tag also printed in physical proximity to each of the articles, the publisher also providing information indicative of a web site, an e-mail address and a telephone number for retrieval from an aggregator;	[037] lines 7-10; [038] lines 5-6, and [039] lines 6-7, “..the web site...”; [051] lines 1-2, “...send an email...”; [053] lines 1-3, “...dial to a publisher’s number or an aggregator’s number...”
Block 404 – Collecting the articles in portable electronic form;	[052] lines 1-4.
Block 405 – Storing the articles in electronic database managed by the aggregator, each of the articles being uniquely retrievable based on the tag corresponding to each article;	[027] lines 1-3; [037] lines 6-7.
Block 406 – Connecting, by the aggregator, the database to the Internet;	[039] lines 6-8; [045] lines 3-4.
Block 407 – Receiving by the aggregator a request from an Internet client through any one of the web site, the e-mail address and the telephone number, the request specifying a tag and the client’s delivery means of either one of the client’s telephone number or e-mail address, the tag having been previously observed by the client from the printed paper form in circulation, the client having previously registered at least one of the client’s telephone number and the e-mail address with the aggregator;	[038] lines 5-6; [039] lines 1-2, 6-10; [045] lines 7-10; [047] lines 1-12; [051] lines 1-3; [053] lines 1-3, 7-8; [055] lines 1-4.
Block 408 – The aggregator authenticating the client based on either one of the Internet client’s telephone number and the client’s e-mail address indicated by the request;	[027] lines 1-4; [039] lines 2-5; [053] lines 3-8.
Block 409 – Retrieving from database to locate the article in portable electronic form matching the at least one tag by the aggregator, upon authenticating the client’s request, and	[027] lines 3-5 [043] lines 1-5; [051] lines 4-5; [052] lines 9-10.
Block 410 – Upon locating the article in electronic form, the aggregator electronically sending the article in portable electronic form to the client based on the client’s delivery means.	[028] lines 5-6; [052] lines 9-10; [053] lines 4-6.

Appl. No. 09/995,931

[08] Amendment to the Claims

[09] Claims 19-25, 27, 28-30 remain pending in the present application, upon the cancellation indicated in the present response.

[10] Rejections under Sec. 102 (e)

[11] Claims 19-23, 25, 27-29 were rejected under 35 USC Sec. 102 (e) as being anticipated by Bengtson. Applicant respectfully traverses the rejection for the reasons that Bengtson does not teach the claimed invention.

[12] The Invention – Recapped

[13] The present invention is directed to facilitating a newspaper (or magazine) reader to quickly retrieve a printed article in portable electronic format via e-mail, after the user has first read or observed the article in printed paper form. For example, a reader of the Food Section or Op-Ed Pages of the Los Angeles Times in paper format may wish to save an article about a recipe or an Essay for future reference, or forward the article to a friend. The conventional way is to physically clip and copy the paper article, which is quite tedious and not conducive for filing or forwarding.

[14] The present invention achieves the goal in a much efficient and useful way, and can be achieved even without requiring the reader to have immediate access to a computer. To that end, the article is first assigned to a unique tag by its publisher prior to printing. When the article is printed in paper format by the publisher, the tag is also printed near the location of the article in paper format. The publisher also publishes ways of retrieving the article: a web site, an e-mail address and a telephone number. At the reader's side, the reader pre-registers either his e-mail address or phone number with the publisher (or a third party aggregator) for authentication and delivery purposes.

[15] Upon observing an article on paper the reader desires to keep, all the reader needs to do is to i) use the tag in an e-mail request to the publisher (or the aggregator), ii) enter the tag by calling the publisher's (or the aggregator's) designated telephone number from the reader's pre-registered telephone number, or iii) use the tag to download from the publisher's (or the aggregator's) designated web site. Upon receiving the request through any one of the channels, the publisher (or the aggregator) can easily authenticate the reader based on the reader's pre-registered e-mail address or telephone number. Then a portable electronic format of the article,

Appl. No. 09/995,931

e.g. PDF, is e-mailed to the reader's pre-registered e-mail address. The retrieval based on the pre-assigned printed tag is much more convenient and efficient, especially when the reader can still make the request, through telecommunications channels such as a wireless or landline telephone, without having a computer nearby. After making the request via a telephone or e-mail, the article in electronic portable format is automatically retrieved and transmitted to the reader's e-mail address. Now, with the portable electronic form of the article, the reader can save it in his own computer files (where key words can be easily assigned for subsequent retrieval), or forward to his friends and associates (where, additionally, the readability of the article is maintained).

[16] The pre-registration of the reader's e-mail address and telephone number allows both authentication and delivery to be done directly, without requiring the reader to enter more information than the tag(s) in his request. If the request is in e-mail, the reader's own e-mail address can be used for both authenticated and delivery. If the request in from the reader's telephone number, the reader's telephone number, e.g. Caller ID, is used for authentication and the reader's pre-registered e-mail address is used for delivery.

[17] The Bengtson Reference

[18] Bengtson discloses serving a web page to a client device based on search index generated from print data received from the publisher. However, the dynamic web page or IP address, in contrast to a static portable electronic document, may change over time, thus leading to an invalid source. Also, the search index is based on print data received from the publisher, where the print data is generated after the article is already published in print. No tag is printed with the article in Bengtson's scenario. To create the search index, the received print data is parsed into key words or phrases, searched for words associated with special attributes and then created by storing page numbers associated with the key words. Then a link database is created by receiving and storing the network links, e.g. IP addresses. (Bengtson, page 6, paragraphs [0046]-[0049]) The operation of Bengtson is heavily dependent on the validity of the web page links maintained in the publication link server (104).

[19] The Mayadas Reference

[20] Mayadas discloses a payment methodology for targeted messaging over a network. Advertisers pay into the system to have their messages distributed according to specified criteria. Payment is made to the users if they view the targeted message. Message publishers are also compensated for publishing the targeted messages. While it discloses a payment scheme,

Appl. No. 09/995,931

Mayadas' payment is made to the readers for reading the messages. The payment is not for the readers to pay for their retrieved articles using a request with a tag. Even if Mayadas can be combined with the teaching of Bengtson, the resulting system still make the present invention as claimed in claims 30, 32, 33-36 obvious.

[21] Patentable Distinctions

[22] The present invention, as claimed, is distinguishable over the primary reference Bengtson with respect to at least the following salient features:

[23] a. The unique tags are pre-assigned by the publisher, and printed in paper form with the articles. (Specification, para. [0034]). No post-print parsing and extraction is needed. Bengtson has to generate its search index from the print data received from the publisher, after the article has been printed in paper. (Bengtson, col. 6, para. [0047]-[0048]). Bengtson's search index is not the same as the publisher-generated and -printed tag of the present invention.

[24] b. The present invention's publisher also indicates an e-mail address, a telephone number or a web site for retrieval. As such, a request from an interested reader can be made through web site download, e-mail request, or telephone request. (Specification, para. [0047], [0052], [0056], [0058]). Requests can be easily transmitted from the reader by making a telephone call to a publisher pre-assigned telephone number, even when the reader is away from his PC. Upon recognizing the reader's telephone number, e.g. through Caller ID, the request is filled by transmitting the requested article to the reader's e-mail box. (Specification, para. [0024], [0056], [0057]). Bengtson does not teach such retrieval methods, either using an e-mail or one through a telephonic gateway. Bengtson only allows its readers to access the link server by receiving the web page when the client is on-line, whereas the present invention does limit to the client being on-line. The request of the present invention can be sent via a telephone call, off-line.

[25] c. The reader in the present invention pre-registers his e-mail address or telephone number with the publisher for authentication. (Specification, para. [0056], [0052]). This pre-registration allows the publisher to authenticate the reader's tag request, since the request is made from a pre-registered telephone (wired or wireless) number, or from a pre-registered recognized e-mail address. To determine a reader's identity, Bengtson needs to rely on a cookie or log-in. (Bengtson, col. 6, para. [0053]). Bengtson does not disclose such pre-registration using either telephone numbers or e-mail addresses. Also, Bengtson does not disclose using the received Internet client's telephone number or e-mail address as authentication.

[26] d. The retrieved article is e-mailed to the reader's e-mail box in portable electronic

Appl. No. 09/995,931

format, which is a static file, as opposed to the target network address, or web page, used by Bengtson. (Bengtson, col. 6, para. [0052]-[0053]; Fig. 6, blocks 606, 608). Before the web page can be sent to Bengtson's readers, the target network address must be determined based on a client query, the search index, and the link database. Once the network address is found from the link database (104), the web page associated with the target network address is transmitted. (Bengtson, col. 6, para. [0051]-[0053]). No such target network address or web page is used in the present invention's retrieval, since the invention seeks to avoid the dependency on the dynamic web pages. (Specification, para. [0015]).

[27] The Claims:

[28] Claim 19, as amended to incorporate limitations recited in claim 26, clearly overcomes and avoids Bengtson because Bengtson does not disclose:

[29] - The articles are pre-assigned to tags by the publisher, which are also printed with the articles when the newspaper or magazine is published in paper form. The tag is not generated by parsing the print data from the publisher as in Bengtson.

[30] - The publisher provides information about retrieval methods: by web site, by e-mail or by telephone.

[31] - A request, with the tag, is made to the web site, the e-mail or the telephone number provided by the publisher. The request also includes either the reader's e-mail address or telephone number, where the reader has pre-registered with the publisher his e-mail address or telephone number.

[32] - Authentication of the request by the publisher is done on either the e-mail address from which the reader sends the request, or the telephone number from which the reader dials the request.

[33] - The article in portable electronic form (vis-à-vis Bengtson's web page and target network address) is retrieved based on the tag, and then forwarded to the reader's e-mail box.

[34] - Upon registration, the reader's email address is collected and stored, which is used both for authentication and delivery.

[35] - The database, where the articles are stores, is accessible through a telecommunications gateway through wireless and landline telephone network. The reader makes a simple telephone call to the publisher's phone number for making a request, whereby the article is e-mailed based on authentication of the reader's telephone number.

Appl. No. 09/995,931

[36] Also, claims 20 and 29 are not anticipated by Bengtson (Bengtson, page 4, [0037]) because Bengtson does not disclose bundling additional information, which is relevant to the subject matter of the article, from another server (Specification, para. [0060]), in real-time or in static form, to the portable electronic form of the article. Bengtson transmits the web page related to the target network address and teaches nothing about bundling relevant information to the article, where the relevant information is provided in real-time or otherwise by another server.

[37] Claim 21 is amended to be dependent from claim 20. Claim 21 recites bundling relevant information to the reader's profile information when an electronic portable form of the article is delivered to the reader. Bengtson does not disclose such relevant information to the reader-supplied profile information in the delivery mode. (Bengtson, col. 5, col. 1, lines 8-10). The 'profile information' in Bengtson cited by the Examiner refers to information indicated in the print data from the publisher as a way to help build the search index. The reliance by the Examiner is inapplicable.

[38] Claim 22, which is dependent on claim 21, as amended recites bundling relevant information during delivery of the article. Bengtson discloses associating various links with pages and chapters of the book when building its link database (Bengtson, col. 5, [0042], lines 1-7). The reliance by the Examiner is inappropriate.

[39] Claim 23, which is dependent on claim 20, has been amended to recite the reader's pre-registration of his telephone number and/or e-mail address, which are also used for authentication when a request is received by the publisher at the publisher's web site, e-mail address or telephone number. Examiner erroneously cited Bengtson at page 5, col. 1, [0041], lines 5-8, which discloses the use of a user name and a password to the link administrators for submitting publication links. It is for administration's adding to the link server, which is not the same as what is claimed for the delivery to the reader. It does not disclose what the user/reader does to pre-register and what the publisher does for authentication of the reader for retrieval purposes.

[40] Claim 25, which is dependent on claim 23, is amended to clarify that a request is transmitted from the reader to the publisher through a wireless or wired telephone connection. Bengtson (pg. 3, col. 1, 0022, lines 1-7) does not disclose the request being made by the reader in a telephone call to the publisher's phone number, where authentication is done based on the reader's pre-registered e-mail address or telephone number.

[41] Claim 27, which is amended to be dependent on claim 23, due to cancellation of claim 26, recites additional tags assigned by the publisher before the article is printed. Bengtson's code is generated from the print data received from the publisher and is associated explicitly with a "target network address" pointing to a web page. (pg. 3, col. 2, 0026, lines 5-10; Fig. 7, right

Appl. No. 09/995,931

column). The invention's tags are associated with the static portable electronic document, which does not depend on a web page. As such, the dependency on the validity of the link is removed in the invention, whereas Bengtson's operation depends on the link or network address to remain valid.

[42] Claim 28, as amended to incorporate limitations from claim 31, is directed to providing a retrieval methodology for a plurality of publications through an aggregator, who manages the database storing the electronic documents. (Specification, [0054]). It is clearly patentable over the cited reference, because Bengtson fails to disclose:

[43] - The articles are pre-assigned to tags by the publisher, which are also printed with the articles when the newspaper or magazine is published in paper form. The tag is not generated by parsing the print data from the publisher as in Bengtson.

[44] - The publisher provides information about retrieval methods through an aggregator: by web site, by e-mail or by telephone.

[45] - A request, with the tag, is made to the web site, the e-mail or the telephone number of the aggregator. The request also includes either the reader's e-mail address or telephone number, where the reader has pre-registered with the aggregator his e-mail address or telephone number.

[46] - Authentication of the request by the aggregator is done on either the e-mail address from which the reader sends the request, or the telephone number from which the reader dials the request.

[47] - The article in portable electronic form (vis-à-vis Bengtson's web page and target network address) is retrieved based on the tag, and then forwarded to the reader's e-mail box by the aggregator.

[48] - Upon registration, the reader's email address is collected and stored, which is used both for authentication and delivery.

[49] - The database, where the articles are stores, is accessible through a telecommunications gateway through wireless and landline telephone network.

[50] - The reader/client uses a simple telephone call to the aggregator's phone number for making a request, whereby the article is e-mailed based on authentication of the reader's telephone number

Appl. No. 09/995,931

[51] Rejections of claims 24 under Sec. 103

[52] Claim 24 is rejected as being unpatentable over Bengtson in view of Carden. For the discussion relating to Bengtson, Applicant respectfully directs the Examiner to the above paragraphs.

[53] Claim 24, which is dependent on claim 20, is amended to further recite that the reader's request includes the tag in the SUBJECT field of the e-mail. No such use of the tag in the SUBJECT field is disclosed. Additionally, by combining Carden with Bengtson, the resulting system, which does not seem to have any motivation for medication, still only provides a web page to the reader via e-mail, whereas the present invention provides a portable electronic document to the reader based on the reader's request with the tag in the SUBJECT field. Therefore, the rejection of claim 24 based on Bengtson in view of Carden is inappropriate and should be withdrawn.

[54] For the above reasons, the rejection under Sec. 103 is inappropriate and is requested to be withdrawn.

[55] Rejection of claim 30 under Section 103

[56] Claim 30 is rejected as being unpatentable over Bengtson in view of Mayadas. For the discussion relating to Bengtson, Applicant respectfully directs the Examiner to the above paragraphs.

[57] With respect to claim 30, Bengtson does not teach pre-registering the readers (Internet clients) and authenticating based on the reader's e-mail address, access code and telephone number.

[58] For the above reasons, the rejection under Sec. 103 is inappropriate and is requested to be withdrawn.

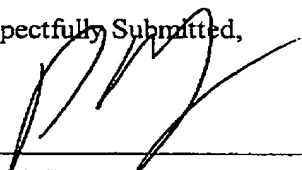
Appl. No. 09/995,931

[59] CONCLUSION

[60] In light of the Amendments and Remarks submitted herein, it is respectfully submitted that the claims as amended are patentable over the cited references. Withdrawal of the Examiner's rejections and allowance is respectfully requested.

[61] The Examiner is encouraged to contact the undersigned to discuss any matter regarding the present application at Tel: 626-965-1202.

Respectfully Submitted,


By: Philip K. Yu, Reg. No. 35,742
Applicant

For Correspondence:

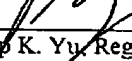
Customer No. 30781

Tel: 626-965-1202

20955 Pathfinder Road, Ste. 100

Diamond Bar, CA 91765

I hereby certify that this correspondence is being transmitted by facsimile to the United States Patent and Trademark Office (Fax No. 703-872-9306) on this date: 12-20-05

By 
Philip K. Yu, Reg. No. 35742